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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/643,604

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John Wallace Nasielski

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EXAMINER

NGUYEN, QUYNH H

ART UNIT

PAPER NUMBER

2614

NOTIFICATION DATE

DELIVERY MODE

03/04/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com  
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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/643,604             | NASIELSKI ET AL.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | QUYNH H. NGUYEN        | 2614                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE and amendment filed 1/8/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-7,9-12,15-18,20-25,27-29 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-12,15-18,20-25,27-29 and 32-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 recites "configured to" clause. The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Claim 23 is drawn to a system comprises various means. It unclear as whether corresponding structure, material or acts are described in the specification in specific terms and one skill in the art could identify the structure, material or acts from that description.

### ***Claim Objections***

3. Claim 34 recites "A processor-readable memory" while specification (paragraph 0068) discloses storage medium. Examiner suggests changing "A processor-readable memory" to -- A tangible storage medium --.

***Claim Rejections - 35 USC § 103***

4. Claims 1, 4-7, 9-12, 15-18, 20-25, 27-29, and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmad et al. (2002/0082029) in view of Pepe et al. (US Patent 5,742,905) and further in view of Hall (US 2002/0080770).

As to claims 1, 12, 23-24, and 34, Ahmad et al. teaches a method of wireless communication comprising:

establishing a packet data session from a wireless communications device to support a network connection to a packet switched network (paragraphs [0007]; [0024]); and

receiving a notification at the wireless communications device of an incoming call from an Internet Call -Waiting Server (paragraph [0038]) from a circuit switch network while the network connection is active (paragraphs [0035] - [0036]).

Ahmad does not explicitly teach receiving a notification from a voice message server.

Pepe teaches receiving messages notification between messaging systems (col. 5, lines 56-67; col. 6, lines 20-33; col. 27, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that receiving a notification could be from an Internet Call-Waiting

server or a voice message server depending on how equipments are arranged / set up. The latter one is the preferred one in the instant application. Receiving message notification from an Internet Call -Waiting Server or a voice message server is merely one of several straightforward possibilities from which the skilled person would select, in accordance with circumstances and/or arrangements, without the exercise of inventive skill.

Ahmad teaches registering from the wireless communications device over the packet data session with a voice message server (*Internet Call -Waiting Server*) to receive the notification (paragraph [0039]). Ahmad and Pepe do not explicitly teach transmitting a registration request from the wireless communications device, over the packet data session to a voice message server to enable the wireless communications device to receive a notification, the registration request including connection information identifying the wireless communications device.

Hall teaches the HLR 114 keeps track of the location of the wireless device whether it is operating in packet or circuit switched mode as the wireless device travels, the VMSC informs the HLR of the wireless device's current location (paragraph 0023). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made that when the wireless device travels to the new location, a registration request transmitted to VLR or roaming in order to operate to service the wireless device at its new location.

As to claims 4-5 and 15-16, Ahmad teaches the use of a session key and a transport control protocol session is considered to be implicit in a packet data session (paragraphs [0036] and [0038]).

As to claims 6-7, 9-11, 17-18, 20-22, and 27, Ahmad teaches terminating the packet data session in response to the notification of the incoming call, and accepting the incoming call from the circuit switched network; receiving the notification at the wireless device and sending a reply over the packet data session from the wireless device in response to the notification (paragraphs [0011], [0036] and [0039]).

As to claim 25, Ahmad teaches receiving notification at the wireless communications device over the packet data session (paragraphs [0036] and [0038]).

As to claims 28 and 33, Ahmad teaches receiving the incoming call at a mobile switching center in the home network while the network connection is active (Fig. 3, voice call 360; [0024] - [0025]), routing a signal from the mobile switching center in the home network to the voice message server in the home network indicating that the wireless communications device is unavailable ([0027], [0037], [0059]), the receipt of the signal at the voice message server in the home network, prompting the routing of the notification of the incoming call from the voice message server in the home network to the wireless communications device ([0011], [0036] and [0039]), routing a reply from the wireless communications device to the voice message server in the home network, and signaling the mobile switching center in the serving network from the voice message server in the serving network to deliver the incoming call to the wireless

communications device in response to the reply ([0006], [0009] - [0011], [0014], [0025], [0030], [0033] - [0035], [0039] - [0042]).

Claim 29 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, operating a wireless device in a serving network, the wireless device being assigned to a home network different from the serving network is known by the skilled person having assigned to a home network can be operating in visitor networks. The communications device is operating in a serving network different from the home network is merely one of several straightforward possibilities from which the skilled person would select, in accordance with circumstances, without the exercise of inventive skill.

Claim 32 is rejected for the same reasons as discussed above with respect to claims 27, respectively and the first limitation of claim 29.

Claims 35, 36 are rejected for the same reasons as discussed above with respect to claims 24 and 28, 28 and 29, respectively.

As to claims 37-39, Hall teaches connection information includes an IP address assigned to the wireless communication device (paragraph 25).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 4-7, 9-12, 15-18, 20-25, 27-29, and 32-39 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUYNH H. NGUYEN whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quynh H Nguyen/

Primary Examiner, Art Unit 2614